

## **REMARKS**

This paper is filed in response to the Office Action dated September 12, 2003. As this paper is filed on March 12, 2004 with a three-month petition for extension of time, the paper is timely filed.

### **I. Status of Amendments**

Claims 1-41 were pending prior to this amendment. By this amendment, applicant amends claims 1, 4, 14, 17, 22, 34, and 39-41. Thus, claims 1-41 remain pending.

Because applicants previously paid fees for 9 independent and 41 total claims, applicants' amendments do not require a further fee to be paid.

### **II. Response to the September 13 Office Action**

Applicant responds to each of the objections and rejections in turn.

#### **Objections to the Drawings**

Figure 3 is objected to because box 100 is not labeled as "controller," in keeping with page 8, lines 3-4: Applicant respectfully submits that there is no requirement that box 100 be labeled as "controller" simply because applicant referred to it as such in the specification, or that every box in a block diagram need be addressed both with textual and numerical indicia. Consequently, this objection should be withdrawn.

Figures 4A and 4B are objected to because the lines are not labeled so that "one having ordinary skill in the art would be able to follow the drawings." Applicant believes the objection to Figs. 4A and 4B is improper; a legend is located on in the upper right-hand corner of Fig. 4A showing how Figs. 4A and 4B match up along their border, and once the skilled practitioner matches the pages, it is submitted that it is both clear and self-evident which flow lines correspond.

Applicant does, however, submit herewith formal drawings that replace the informal drawings filed with the application on January 25, 2002. It is submitted that the formal

drawings address the objections raised in the Notice of Draftsperson's Patent Drawing Review.

### **Objections to the Specification**

An objection is raised to the abstract. It would appear that the only informality in the abstract is the use of "said" in two instances. The abstract has been amended to replace "said" with "the" in both instances.

A further objection is raised to the specification for lacking a summary of the invention. 37 C.F.R. 1.73 states (emphasis added):

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, *when set forth*, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

It is apparent from the text of section 1.73 that the inclusion of a summary is optional ("when set forth"), and that section 1.73 recites where and how it should be presented, if it is presented. Applicant is not opposed to adding a summary of the invention once the scope of the allowable claims is known.

Applicant is unaware of any other errors, alleged or otherwise, in the specification.

### **Objections to the Claims**

Claims 39-41 are objected to because the claims do not recite that the memory is a "computer-readable memory", despite the fact that the claims recite "a memory having a computer program stored therein". As such an amendment does not change the scope of the claims, applicants have amended the claims as suggested.

Claims 21, 33, and 38 are objected to because the claims recite the "Internet". After repeatedly reviewing the objection, applicant is not able to determine the exact nature of or basis for the objection. Moreover, it would appear that the remarks are extortive ("it is strongly urged that Applicant consider") rather than mandatory. Taken in this light, applicant respectfully declines to amend claims 21, 33 and 38 to remove reference to the Internet.

Further, applicant notes that claims 20, 32, and 37 (from which claims 21, 33, and 38 depend) recite the interconnection between the gaming apparatuses more broadly than just the Internet: “said gaming apparatuses being interconnected to form a network of gaming apparatuses.”

Claims 1, 13, 17, 31, and 39 are objected to as including improper Markush groups. Applicant submits that the claiming structure used is an appropriate recitation in the alternative, and is not intended to be a Markush group. As explained in the Manual of Patent Examining Procedure (“MPEP”) 2173.05(h), claiming in the alternative is not *per se* inappropriate: “Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims.” Moreover, Markush claims are but “one acceptable form of alternative expression.” *Id.* Consequently, the applicant has not amended claims 1, 13, 17, 31, and 39 in regard to this objection.

**Rejections under 35 U.S.C. 112, second paragraph**

Claims 10 and 17-41 are rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite.

In regard to claim 10, applicant respectfully disagrees. Claim 7 recites that “displaying a value amount when the player selects one of the game piece images from the plurality of game piece images.” Claim 10 recites “displaying value amounts for the game piece images of the plurality of game piece images other than the one of the game piece images (antecedent in claim 7: one of the game piece images) after displaying the value amount (antecedent in claim 7: a value amount)”. Consequently, consistent terminology has been used.

In regard to claims 17, 22 and 34, the claims do indeed recite a display unit that is “capable of generating video images,” the controller being programmed to cause “a video image to be generated on said display unit”. No correction is required.

In regard to claims 39-41, the suggested amendment has been made, although given that the amendment is merely bringing the preamble into allegedly better correspondence with the body of the claim, applicant submits that no change has been made in the scope of the claim.

**Rejections under 35 U.S.C. 102(b), 103**

Claims 1-6, 12-20, 22-24, 30-32, 34-37, and 39-41 were rejected under 35 U.S.C. 102(b) as allegedly anticipated by Walker et al. (U.S. Patent No. 6,077,163). Claims 7-10 and 25-28 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Walker et al. in view of Colin et al. (U.S. Patent No. 6,346,043), claims 11 and 29 as allegedly unpatentable over Walker et al. in view of Colin et al. further in view of Bennett (U.S. Patent No. 6,102,798), and claims 21, 33, and 38 as allegedly unpatentable over Walker et al. Applicants believe that the rejections should be withdrawn.

Claim 1, for example, recites, in part, receiving a value amount to initially define a value total, causing a video image representing a game to be generated, deducting a fee at intervals from the value total independent of play of said game represented by said video image and independent of input from a player, determining based on the fee a value payout associated with an outcome of said game represented by said video image, and adding the value payout to the value total. Applicant submits that “deducting a fee at intervals from the value total independent of play of said game represented by the video image and independent of input from a player” is not disclosed, taught or suggested by Walker et al.

Walker et al. states (col. 3:21-28):

The gaming device stores the player selected price parameters and proceeds to retrieve the flat rate price of playing the gaming device for the flat rate play session. The player selected price parameters, in combination with operator price parameters, determine the flat rate price. Should the player decide to pay the flat rate price, the player simply deposits that amount into the gaming device or makes a credit account available for the gaming device to debit.

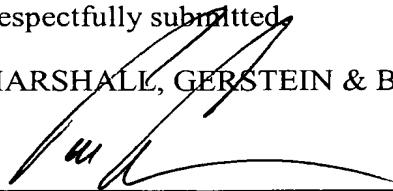
Thus, the allegedly corresponding interval of Walker et al. (“session”) is dependent upon input from the player (acceptance of the length of the flat fee session, and the variable choices made arriving at the length of the flat fee session) in Walker et al. Moreover, there is nothing in Walker et al. to suggest or teach that the allegedly corresponding intervals (sessions) are selected independent of some player input. Consequently, claim 1 is not anticipated by or obvious in view of Walker et al.

It is applicant's further position that nothing in Colin et al. or Bennett provides the missing disclosure, teaching or suggestion of Walker et al. Consequently, even if taken in combination, Walker et al., Colin et al. and Bennett do not disclose, teach or suggest each and every limitation of the claimed subject matter of claim 1.

Given that claims 2 and 3 depend from claim 1 and that claim 1 is distinguishable from Walker et al., so too are claims 2 and 3. Moreover, it is applicant's position that the arguments distinguishing claim 1 from Walker et al. are applicable with equal force to claims 4, 14, 17, 22, 34, 39, 40, and 41, and thus claims 4, 14, 17, 22, 34, 39, 40, and 41 also are patentable over Walker et al. It further follows that as claims 4, 14, 17, 22, 34, 39, 40, and 41 distinguish Walker et al. and claims 5-13, 15-16, 18-21, 23-33, and 35-38 depend from claims 4, 14, 17, 22, 34, 39, 40, and 41, respectively, these claims are patentable over Walker et al., or some combination of Walker et al., Colin et al., and Bennett, as well. Therefore, the rejections of claims 2-41 as allegedly unpatentable over Walker et al., or some combination of Walker et al., Colin et al. and Bennett, should be withdrawn.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

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